



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Thomas G. RUFF *et al.*

Appl. No.: 09/849,526

Filed: May 7, 2001

Title: Nucleic Acid Molecules and Other  
Molecules Associated with Plants

Confirmation No: 7991

Art Unit: 1631

Examiner: To Be Assigned

Atty. Docket: 38-21(51930)B

**Request to Rescind Prior Request and Certification  
Under 37 C.F.R. § 1.213(b);****Petition for Revival of an Unintentionally Abandoned  
Patent Application Under 37 C.F.R. § 1.137(f); and  
Petition for Express Abandonment Under 37 C.F.R. § 1.138(c)**

**Mail Stop Petition**  
 Commissioner for Patents  
 P.O. Box 1405  
 Alexandria, VA 22313-1450

**OK FOR ABANDONMENT**

NOV 5 2003

Sir:

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INITIALS QJD**RECEIVED**

AUG 28 2003

Applicants hereby petition in the above-captioned U.S. Application to:

**OFFICE OF PETITIONS**

(1) rescind the Request for Non-Publication and Certification filed on May 7, 2001, in the above-captioned U.S. Application in accordance with 37 C.F.R. § 1.213(b);

(2) revive the above-captioned U.S. Application under 37 C.F.R. § 1.137(f), for purposes of establishing co-pendency with child applications Serial No. (not yet assigned), filed April 28, 2003, naming Thomas J. La Rosa, Yihua Zhou, David K. Kovalic, Yongwei Cao, Jingdong Liu as inventors and having Attorney Docket No. 38-21(53222)B (the "First Child Application") and Serial No. (not yet assigned), filed July 2, 2003, naming Thomas J. La Rosa, Yihua Zhou, David K. Kovalic, Yongwei Cao, Jingdong Liu as inventors and having Attorney Docket No. 38-21(53373)A (the "Second Child Application"); and

(3) expressly abandon the above-captioned U.S. Application under 37 C.F.R. § 1.138(c) as of the later of the respective filing dates granted to the First Child Application and the Second Child Application, for purposes of avoiding publication of the above

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captioned U.S. application. Authorization to charge the official fees for this Petition is given in the accompanying transmittal letter. A duplicate copy of this Petition is enclosed.

The grant of the present Petition by the Office will result in:

(1) a rescission of the Request for Non-Publication and Certification filed on May 7, 2001, in Application Serial No. 09/849,526;

(2) revival of Application Serial No. 09/849,526, which was unintentionally abandoned under 37 C.F.R. § 1.137(f);

(3) copendency of Application Serial No. 09/849,526 with child application Serial No. (not yet assigned) filed April 28, 2003, naming Thomas J. La Rosa, Yihua Zhou, David K. Kovalic, Yongwei Cao, Jingdong Liu as inventors and having Attorney Docket No. 38-21(53222)B (the First Child Application);

(4) copendency of Application Serial No. 09/849,526 with child application Serial No. (not yet assigned), filed July 2, 2003, naming Thomas J. La Rosa, Yihua Zhou, David K. Kovalic, Yongwei Cao, Jingdong Liu as inventors and having Attorney Docket No. 38-21(53373)A (the Second Child Application); and

(5) express abandonment of Application Serial No. 09/849,526 as of the later of the respective filing dates granted to the First Child Application and the Second Child Application in order to avoid publication of the above-captioned application.

***The Incorrect Certification Under 35 U.S.C. § 122(b)(2)(B)(i)***

On May 7, 2001, the above-captioned U.S. application was filed with a Request for Non-Publication, which contained a certification under 35 U.S.C. § 122(b)(2)(B)(i), including a statement that the invention "has not and will not be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing." (Request attached hereto as Exhibit A). Thereafter it was discovered that one or more foreign applications, which may be related to the invention disclosed in the above-captioned U.S. application, were previously filed in another country or under a

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multilateral agreement that requires publication at eighteen months after filing. One such application was filed on April 13, 2001 (the "Previous Foreign Application").<sup>1</sup>

Therefore, Applicants believe that when the above-captioned U.S. Application was filed the certification under 35 U.S.C. § 122(b)(2)(B)(i) may have been incorrect, and wish to rescind the request for non-publication filed in the above-captioned U.S. application.

Applicants believe the certification in the above-captioned U.S. Application may have been incorrect because the Previous Foreign Application is directed to one or more nucleic acid or amino acid sequences, or both, that exhibit at least 85% sequence identity over 80% of their length to one or more nucleic acid or amino acid sequences, or both, disclosed in the above-captioned U.S. Application.<sup>2</sup>

In light of the above, Applicants hereby explicitly notify the Office of the filing of the Previous Foreign Application on April 13, 2001, and rescind the request for non-publication submitted in U.S. Application Serial No. 09/849,526 pursuant to 37 C.F.R. § 1.213(b). Applicants assert that any incorrect certification made under 35 U.S.C. § 122(b)(2)(B)(i) was inadvertent.

***The Unintentional Abandonment Pursuant to 35 U.S.C. § 122 (b)(2)(B)(iii)***

It was also discovered that one or more foreign applications, which may be related to the invention disclosed in the above-captioned U.S. application, were subsequently filed in another country or under a multilateral agreement that requires publication at eighteen months after filing. One such application was filed on December 4, 2002 (the "Subsequent Foreign Application").<sup>3</sup>

Applicants inadvertently did not notify the Director of the filing of the Subsequent Foreign Application within 45 days of its filing. Therefore, Applicants believe that the

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<sup>1</sup> Where more than one application was filed in another country or under a multilateral agreement, only the date for the earliest-filed foreign application is recited herein.

<sup>2</sup> Applicants do not assert that nucleic acid sequences or amino acid sequences that exhibit at least 85% identity over 80% of their length either are or are not an "invention disclosed in the application" within the meaning of 35 U.S.C. § 122.

<sup>3</sup> Where more than one application was filed in another country or under a multilateral agreement, only the date for the earliest-filed foreign application is recited herein.

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above-captioned U.S. application may be abandoned pursuant to 35 U.S.C. § 122 (b)(2)(B)(iii), because the Subsequent Foreign Application is directed to one or more nucleic acid or amino acid sequences, or both, that exhibit at least 85% sequence identity over 80% of their length to one or more nucleic acid or amino acid sequences, or both, disclosed in the above-captioned U.S. application.<sup>4</sup>

In light of the above, Applicants hereby explicitly notify the Office of the filing of the Subsequent Foreign Application on December 4, 2002, pursuant to 35 U.S.C. § 122 (b)(2)(B)(iii). Applicants assert that any delay of providing such notice to the Office was inadvertent.

Applicants hereby petition for revival of U.S. Application Serial No. 09/849,526 under 37 C.F.R. § 1.137(f), for purposes of establishing co-pendency with the above-referenced child applications. Applicants hereby assert that any and all delay in filing the required reply, *i.e.*, notification to the Office of the Subsequent Foreign Application, from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional and respectfully request that the above-captioned U.S. application be revived.

***The Express Abandonment of the Above-Captioned U.S. Application***

Applicants also hereby petition for express abandonment of U.S. Application Serial No. 09/849,526 under 37 C.F.R. § 1.138(c) as of the later of the respective filing dates granted to the First Child Application and the Second Child Application, for purposes of avoiding publication of the above-captioned U.S. application.

The above-captioned U.S. application contains multiple sequences, only some of which meet the criteria such that those sequences may be considered to be the “invention disclosed” within the meaning of 35 U.S.C. § 122. However, in lieu of submitting a redacted copy of the above-captioned U.S. application, provided for under 35 U.S.C. § 122 (b)(2)(B)(v), Applicants have elected to pursue the present course of action of refiling two applications, one containing those sequences which may be disclosed in the above-referenced

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<sup>4</sup> Applicants herein reiterate the statement made in footnote 2, *supra*.

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foreign applications without a request for non-publication, and one application containing sequences which were not disclosed in the above-referenced foreign applications with a request for non-publication.

### Conclusion

In accordance with the facts set out herein, Applicants hereby petition to:

- (1) rescind of the Request for Non-Publication and Certification filed on May 7, 2001, in Application Serial No. 09/849,526;
- (2) revive U.S. Application Serial No. 09/849,526 as unintentionally abandoned under 37 C.F.R. § 1.137(f); and
- (3) expressly abandon the U.S. Application Serial No. 09/849,526 under 37 C.F.R. § 1.138(c), to avoid publication, as of the later of the respective filing dates granted to the First Child Application and the Second Child Application.

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Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below. The undersigned is an attorney of record, or an attorney acting in a representative capacity for Applicants by virtue of being named in the transmittal papers accompanying the above-referenced child applications, and therefore has authority to petition for abandonment of the above-captioned U.S. application in favor of the above-referenced child applications pursuant to 37 C.F.R. § 1.138(b), 1.33(b), and 1.34(a).

Respectfully submitted,

*Lawrence M. Lavin, Jr.*

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by David R. Marsh (Reg. No. 41,408)  
Holly Logue Prutz (Reg. No. 47,755)

*by Holly Logue Prutz*

Date: August 26, 2003

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